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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,913	08/22/2001	Cary L. Bates	END920010062US1	8413

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IBM Corporation
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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/934,913	BATES ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's amendment of 1-13-05 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The amendment filed 1-13-05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The recitation to a "digital" computer and "digital" chance table in claims 48-50. The specification as originally filed does not appear to provide support for the term "digital" and nothing in the disclosure leads the examiner to believe that this limitation is inherent in the original disclosure.

The specification as originally field does not provide support for there being two response control processors as has been recited in claim 48. Having a 2nd response control processor is considered to be new matter.

If applicant contends that the above limitations are not new matter, the examiner requests that applicant specifically point out where support in the specification as originally filed can be found.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 48-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are rejected for the same reason that the amendment was objected to for new matter. The specification as originally filed does not appear to provide support for the term "digital" and nothing in the disclosure leads the examiner to believe that this limitation is inherent in the original disclosure.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 48-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 48,50, what does a service level of "chance" mean? This is not clear because the limitation of service level appears to be the manner in which the customer would like the video image sent. Email and mail are the other two recited service levels but it is not known what a service level of "chance" means. In line 22 of claim 48 (also found in cl. 50), with respect to the recitation of "operating a response control processor", is this the same response control processor as was recited in line 16 or is this a second response control processor? This is not clear. The examiner does not see where a 2nd response control processor has been disclosed so it appears that the control processor of line 22 may in fact be the same as recited in line 16 but the language of the claim indicates otherwise. Clarification and correction is required. With respect to the language "having a corresponding selection probability to select

responsive to said corresponding selection probability" makes no sense to the examiner. What does the selection probability correspond to? Corresponding to what? What is being selected? The corresponding selection probability is to select responsive to itself (the selection probability)? This is very confusing language and renders the claim indefinite. In lines 29 and 37 of claim 48 (also found in cl. 50), the limitation of "said response control processor" is referring to which response control processor, the one of line 16 or the one recited in line 22? Two have been claimed.

For claim 49, what does a service level of "chance" mean? This is not clear because the limitation of service level appears to be the manner in which the customer would like the video image sent. Email and mail are the other two recited service levels but it is not known what a service level of "chance" means. In line 28, with respect to the recitation of "operating a response control processor", is this the same response control processor as was recited in lines 21-22 or is this a second response control processor? This is not clear. The examiner does not see where a 2nd response control processor has been disclosed so it appears that the control processor of line 28 may in fact be the same as recited in lines 21-22, but the language of the claim indicates otherwise. Clarification and correction is required. With respect to the language "having a corresponding selection probability to select responsive to said corresponding selection probability" makes no sense to the examiner. What does the selection probability correspond to? Corresponding to what? What is being selected? The corresponding selection probability is to select responsive to itself (the selection probability)? This is very confusing language and renders the claim indefinite. In lines

36-37 and 44-45, the limitation of "said response control processor" is referring to which response control processor, the one of lines 21-22 or the one recited in line 28? Two have been claimed.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novais et al. (20030023452).

Novais discloses a system and method for recording images of a person's seat location during an event at an arena. A computer 15 is operated as a vend processor (15 is a processor) to vend a probability and service level as claimed. The selection probability is 100% because if you pay for the service it is assumed they will take the

pictures. The selection probability is 100%, which is included in the scope of the claim (the disclosed assurance of having your picture taken discussed in the instant specification). The service level is disclosed in paragraphs 29,31,34 and 36 and includes email, mail, digital copy, and/or transmission to a cell phone. The recited chance table is interpreted to be the database file that is created when the customer enters their information into the system 15. The customer file will include the seat location and service level as claimed. With respect to the recited data element of "selection probability", because nothing in the claim actually uses the selection probability in any manner, this limitation is considered to be non-functional descriptive material and the kind of data recited will not be given patentable weight; therefore, the limitation of loading the selection probability into a chance table is just interpreted to be a 3rd piece of data that is entered by the customer and this can be interpreted to be the name of the customer or any other information such as an address. The act of just loading the selection probability into a table with no further use of the probability in another step renders the selection probability as non-functional descriptive material that does not serve as a limitation (*In re Gulack*, 217 USPQ 401 (CAFC 1983)). Novais discloses that cameras 10 are operated to record images of seat locations having entries in the chance table. This portion of the claim is essentially reciting that all entries (all customers that have requested the service) have their seat locations recorded, which is what occurs in Novais. The claim does not require that less than all the entries have their location recorded. The step of operating a processor to select images for transmission is satisfied by Novais because the processor selects images to

transmit based on what photo package the customer has chosen (the kind of images desired). Applicant should take notice that this portion of the claim is not actually using the selection probability to choose whom to record (no further use of the probability data) because the claim specifies that the processor selects images for transmission from "video images" and this has nothing to do with the selection probability data element. As the claim is best understood by the examiner Novais discloses the claimed service levels. With respect to the recitation of a 1st, 2nd and 3rd customer, where emailing, mailing a digital recording, and chance (?) are the service levels, this is not explicitly disclosed by Novais. Novais does not disclose that there are 3 customers where one chooses chance, one chooses email, and one chooses mail. It would have been obvious to one of ordinary skill in the art at the time the invention was made that with the number of persons attending an event at an arena (can be in the thousands and more likely in the tens of thousands for professional sporting events) it would have been obvious that some would choose the email service level, some would choose the mail service level (with hard copy) and some would choose chance service level (?). The service levels are chosen by the customers and can vary. All of the recited service levels are offered by Novais so reciting that there are 3 customers with the recited 3 different service levels is considered obvious in view of Novais because one would expect that all service levels would be used by the various customers. With respect to the recitation that the 2nd customer uses a set top (box?) to display the emailed images, a set top box is well known in the art and the examiner interprets this to be the same as a computer, because a set top box is a simply small computer processor. Anyone who

has pictures emailed to themselves will inherently have to use a computer of some kind to view the images. The examiner finds it inherent that the recited instructions are stored on a storage medium in Novais. The system of Novais inherently has a storage medium with instructions stored thereon.

9. Applicant's arguments filed 1-13-05 have been fully considered but they are not persuasive.

With respect to the citing of section 707.02(j) and section 707.03 of the MPEP, these sections do not exist. MPEP 707.02 is for applications that have had 3 office actions or that have been pending for 5 years, neither of which apply to this case and there is no section (j) for 707.02. There is no section 707.03. With respect to the overall request for assistance and suggestions to place the application in condition for allowance it is not apparent to the examiner that the there has been disclosed patentable subject matter and in view of the claims and arguments it is not apparent that there is patentable subject matter.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER